

REMARKS

Claims 1-19 are pending in the present Application, and all claims currently stand rejected. Claims 1, 5, and 9 are amended, and new claims 20-21 are added herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 103

On page 3 of the Office Action, the Examiner rejects claims 1-4 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0041329 to Steinberg (hereafter Steinberg) in view of U.S. Patent No. 6,396,537 to Squilla et al. (hereafter Squilla). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that certain basic criteria be met. In particular, Applicants submit that the cited prior art reference (or references when combined) should properly teach all the claim limitations recited by Applicants. The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Applicants submit that this burden has not been adequately met because the cited prior art fails to teach all of Applicants' claimed limitations.

Regarding the Examiner's rejections of independent claims 1 and 9, Applicants submit that amended claims 1 and 9 recite limitations that are not taught or suggested either by the cited references, or by the Examiner's citations

thereto. For example, claim 1 explicitly recites “*said digital camera being physically incapable of communicating, either directly or indirectly, with any external device other than said exclusive and remote location*” (emphasis added).

Steinberg essentially teaches a “messaging center” that sends various types of messages to a camera for display to a camera user (see Abstract). However, Steinberg also teaches that the camera can interface with “a programmable card” to exchange information “from the network through a computer 40 connected to the network by cables” (see paragraph 0033). Applicants submit that the camera of Steinberg may also readily receive information from computer 40 that was obtained from sources other than the messaging center.

In addition, the camera of Steinberg may also receive information from transceiver 18 that is transmitted to the “network” from sources other than the messaging center. Therefore, since the camera of Steinberg clearly communicates with computer 40, Applicants submit that Steinberg fails to disclose “*a digital camera configured to send the image data exclusively to the remote storage device and to receive advertising data exclusively from the remote storage device,*” as claimed by Applicants. For at least the foregoing reasons, Applicants submit that

On page 4 of the Office Action, the Examiner concedes that Steinberg “fails to specifically state that the digital camera is configured to send image data captured by the camera to the remote storage device. Applicants concur. The Examiner then points to Squilla to purportedly remedy these deficiencies. Applicants traverse.

Squilla teaches sending content information related to a visual attraction to a camera (either film or digital) based upon “user personality data.” However, no advertising information is transferred in Squilla. In addition, Squilla only tangentially mentions capturing image data, and transferring the image data does not trigger downloads of the content information to the camera, as disclosed and claimed by Applicants.

Furthermore, communications to and from the camera of Squilla are not “exclusive,” as claimed by Applicants (see Fig. 2). Therefore, Squilla fails to teach “*said digital camera being physically incapable of communicating, either directly or indirectly, with any external device other than said exclusive and remote location,*” as claimed by Applicants. For at least the foregoing reasons, Applicant submit that claims 1 and 9 are not unpatenable over the cited references.

Regarding the Examiner’s rejection of dependent claims 2-4 and 10-11, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested.

For at least the foregoing reasons, the Applicants submit that claims 1-4 and 9-11 are not unpatentable under 35 U.S.C. § 103 over Steinberg in view of Squilla, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-4 and 9-11 are under 35 U.S.C. § 103.

On page 10 of the Office Action, the Examiner rejects claims 5-8 and 12-19 under 35 U.S.C. § 103 as being unpatentable over Steinberg and Squilla in view of U.S. Patent No. 6,442,529 to Krishan et al. (hereafter Krishan). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should properly teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

With regard to the Examiner's rejection of independent claim 5, Applicants submit that claim 5 recites limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto. For example, claim 5 explicitly recites "*uploading image data from a digital camera solely to an exclusive and predetermined remote location*" and "*said digital camera being physically incapable of communicating, either directly or indirectly, with any external device other than said exclusive and remote location.*"

On page 13 of the Office Action, the Examiner explicitly concedes that the combination of Steinberg and Squilla "fails to distinctly state that the digital camera is unable to exchange electronic information with any electronic devices except for the exclusive and predetermined location." Applicants concur. The Examiner then points to Krishnan to purportedly remedy these defects.

Krishnan teaches advertisers subsidizing Internet access through “mini-portal devices” (see column 3, lines 38-45). However, Krishnan explicitly teaches variously communicating with a “validation server”, an “advertisement server”, a “content server”, and a “statistics server” (see column 4, lines 7-37). Applicants therefore submit that none of the cited references teach “*said digital camera being physically incapable of communicating, either directly or indirectly, with any external device other than said exclusive and remote location*”, as claimed by Applicants.

Regarding the Examiner’s rejection of dependent claims 6-8 and 12-19, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 6-8 and 12-19, so that these claims may issue in a timely manner.

With further regard to claim 13, the Examiner cites Krishnan in support of the rejection of claim 13 which explicitly recites “*said digital camera displaying said advertising data in an automatic manner, a device user of said digital being unable to prevent said displaying*” (emphasis added). However, Krishnan explicitly states that “[u]sers who object to receiving advertising material . . . may opt out . . .” (see column 6, lines 65-66). Krishnan therefore teaches that users are able to prevent displaying of the advertising if they choose. For at least the

foregoing reasons, Applicants respectfully request reconsideration of the rejection of claim 13.

With regard to the rejection of claim 14, the Examiner cites Krishnan in support of the rejection of claim 14 which explicitly recites “*a distributor of said digital camera administers and maintains said exclusive and predetermined remote location*” (emphasis added). In contrast, Krishnan is limited to teaching a “portal provider 20” of “mini-portals.” Applicants submit that Krishnan nowhere discloses a “*distributor of said digital camera,*” as claimed by Applicants. For at least the foregoing reasons, Applicants respectfully request reconsideration of the rejection of claim 14.

With further regard to the rejection of dependent claim 15, Applicants submit that neither of the cited references disclose or mention any sort of “*combined download/upload request*”, as claimed by Applicants. The claimed “combined download/upload request” is described in detail in conjunction with the discussion FIG. 4 of Applicants’ Specification. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 15 under 35 U.S.C. § 103.

With regard to the rejection of dependent claim 16, the Examiner states that “Krishnan also states that validation stamps are periodically sent” (emphasis added). In contrast, Applicants recite a “*combined download/upload request occurring at predetermined regular intervals.*” Applicants submit that sending validation stamps “periodically” does not necessarily mean that the validations stamps are sent at “predetermined regular intervals,” as claimed by

Applicants. For example, sending validation stamps “periodically” could readily occur at intervals that were neither “predetermined” nor “regular.” The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 16 under 35 U.S.C. § 103.

With regard to the rejection of dependent claim 19, Applicants submit that none of the cited references disclose or mention a protocol in which “*downloading of said advertising data is triggered by said uploading image data,*” as claimed by Applicants. The foregoing claimed upload/download technique is described in Applicants’ Specification at page 9, lines 1-3. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. § 103.

For at least the foregoing reasons, the Applicants submit that claims 5-8 and 12-19 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 5-8 and 12-19 are under 35 U.S.C. § 103.

New Claims

The Applicants herein submit additional claims 20-21 for consideration by the Examiner in the present Application. The new claims 20-21 recite specific detailed embodiments for implementation and utilization of Applicants' invention, as disclosed and discussed in the Specification. Applicants submit that newly-added claims 20-21 contain a number of limitations that are not taught or suggested in the cited references. For example, claim 20 recites that an advertiser compensates both exclusive and remote location and a distributor of said digital camera for downloading said advertising. Support can be found on page 7, lines 1-5, of the Specification. In addition, claim 21 recites that said camera obtains said image data back from said exclusive and predetermined location for viewing by a camera user after said uploading has occurred. Support can be found on page 8, lines 10-15, of the Specification. Applicants therefore respectfully request the Examiner to consider and allow new claims 20-21, so that these claims may issue in a timely manner.

Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-21, so that the present Application may issue in a timely manner. If there are any questions concerning this Response, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

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By: _____



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